

ESTTA Tracking number: **ESTTA597298**

Filing date: **04/08/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	j2 Global, Inc.
Granted to Date of previous extension	04/09/2014
Address	6922 Hollywood Boulevard 5th Floor Hollywood, CA 90028 UNITED STATES
Attorney information	Robert W. Zelnick; Bess Morgan McDermott Will & Emery LLP 500 North Capitol Street, NW Washington, DC 20001 UNITED STATES dcipit@mwe.com, rzelnick@mwe.com, bmorgan@mwe.com, ksandacz@mwe.com

Applicant Information

Application No	85906972	Publication date	12/10/2013
Opposition Filing Date	04/08/2014	Opposition Period Ends	04/09/2014
Applicant	KeepSafe Software, Inc. 427 Bryant St. San Francisco, CA 94107 GERMANY		

Goods/Services Affected by Opposition


Class 009. First Use: 2011/10/00 First Use In Commerce: 2011/10/00
All goods and services in the class are opposed, namely: Computer application software for mobile phones, namely, software for importing, hiding and locking photo images, videos and sms messages

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4234642	Application Date	02/22/2011
Registration Date	10/30/2012	Foreign Priority Date	NONE
Word Mark	KEEPITSAFE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2006/10/19 First Use In Commerce: 2006/10/19 Computer programs for use in processing data in the fields of disaster recovery, data archival and data backup; database management software for use in the fields of disaster recovery, data archival and data backup; computer programs for providing remote data archival and backup Class 042. First use: First Use: 2006/10/19 First Use In Commerce: 2006/10/19 Computer services, namely, data recovery services; Computer disaster recovery planning services in the field of data communications systems

U.S. Registration No.	4203061	Application Date	02/22/2011
Registration Date	09/04/2012	Foreign Priority Date	NONE
Word Mark	KEEPITSAFE		
Design Mark			
Description of Mark	The mark consists of the wording "KEEPITSAFE" to the right of a stylized safe design.		
Goods/Services	Class 009. First use: First Use: 2006/10/19 First Use In Commerce: 2006/10/19 Computer programs for use in processing data in the fields of disaster recovery, data archival and data backup; database management software for use in the fields of disaster recovery, data archival and data backup; computer programs for providing remote data archival and backup Class 042. First use: First Use: 2006/10/19 First Use In Commerce: 2006/10/19 Computer services, namely, data recovery services; Computer disaster recovery planning services in the field of data communications systems		

Attachments	85248343#TMSN.jpeg(bytes) 85248346#TMSN.jpeg(bytes) Notice of Opposition.pdf(281310 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address

record by First Class Mail on this date.

Signature	/Bess Morgan/
Name	Robert W. Zelnick; Bess Morgan
Date	04/08/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

J2 GLOBAL, INC.,

Opposer,

v.

KEEPSAFE SOFTWARE, INC.,

Applicant.

Opposition No. _____

Serial No: 85/906,972

Mark: KEEPSAFE

NOTICE OF OPPOSITION

J2 GLOBAL, INC., a corporation organized and existing under the laws of Delaware, having its principal place of business at 6922 Hollywood Boulevard, 5th Floor, Hollywood, CA 90028 (“Opposer”) will be damaged by registration of the mark “KEEPSAFE” in U.S.

Application Ser. No. 85/906,972, filed by KeepSafe Software, Inc., a corporation organized and existing under the laws of Delaware, located at 427 Bryant Street, San Francisco, CA 94107 (“Applicant”), and opposes registration of same.


1. Opposer is one of the largest and best known global providers of data and telecommunications solutions, among other goods and services. Opposer earns hundreds of millions of dollars in revenue annually and serves customers in 49 countries on six continents. Since as early as 2006, Opposer and its predecessors have developed, promoted, distributed and sold software and related goods and services under the mark KEEPITSAFE, including the goods and services identified in the registrations cited in Paragraph 4, below.

2. For nearly a decade, and since long prior to Applicant’s filing of its application to register the mark KEEPSAFE and prior to any uses thereof by Applicant, Opposer and its

predecessors have used, advertised and promoted in commerce, and Opposer continues to use, advertise and promote in commerce, Opposer's KEEPITSAFE marks in connection with Opposer's products and services, including but not limited to the goods and services cited in Paragraph 4, below.

3. Opposer's KEEPITSAFE products are widely available in the United States and are available for purchase and installation via a variety of means, including but not limited to direct download by consumers through internet app stores, such as iTunes® and Google Play™.

4. Opposer owns extensive common law rights to its KEEPITSAFE marks. Opposer also owns the below-referenced U.S. registrations for KEEPITSAFE. (Hereafter these registered and common law marks are collectively referred to as the "KEEPITSAFE Marks."). Among Opposer's federally registered marks are the following:

Trademark	Reg. No.	Reg. Date	Full Goods and Services
KEEPITSAFE	RN:4,234,642	October 30, 2012	(Int'l Class: 9) Computer programs for use in processing data in the fields of disaster recovery, data archival and data backup; database management software for use in the fields of disaster recovery, data archival and data backup; computer programs for providing remote data archival and backup (Int'l Class: 42) Computer services, namely, data recovery services; computer disaster recovery planning services in the field of data communications systems
KEEPITSAFE and Design 	RN:4,203,061	September 4, 2012	(Int'l Class: 9) Computer programs for use in processing data in the fields of disaster recovery, data archival and data backup; database management software for use in the fields of disaster recovery, data archival and data backup; computer programs for providing remote data archival and backup (Int'l Class: 42) Computer services, namely, data recovery services; computer disaster recovery planning services in the field of data communications systems

Copies of these registration certificates are annexed as Exhibit A. Opposer's aforesaid registrations are valid and subsisting and in full force and effect.

5. Opposer's KEEPITSAFE Marks are distinctive and were first used in commerce long prior to Applicant's alleged first use date of October 2011.

6. As one of Opposer's core brands, Opposer has expended substantial resources to advertise and promote Opposer's products and services under the KEEPITSAFE Marks over the years. For many years, consumers have associated Opposer's KEEPITSAFE Marks as identifying goods and services emanating exclusively from Opposer.

7. Notwithstanding Opposer's rights to the mark KEEPITSAFE, on April 17, 2013, Applicant filed Serial No. 85/906,972 for "KEEPSAFE" for computer application software in Class 9.

8. Applicant's herein-opposed application was published for opposition on December 10, 2013 in the Official Gazette (Trademarks) of the United States Patent and Trademark Office. Opposer was granted an extension of time until April 9, 2014 to file a notice of opposition. Therefore, this Notice of Opposition is being timely filed.

9. Applicant's mark KEEPSAFE is substantially identical and confusingly similar to Opposer's KEEPITSAFE Marks, both individually and collectively, in appearance, pronunciation, meaning, and commercial impression.

10. The goods offered under Applicant's mark, as identified in its application, are highly related to and overlapping with the goods and services offered by Opposer. Applicant's goods perform functionality that is similar and related to the products and services with which Opposer uses and has registered its KEEPITSAFE Marks.

11. Applicant goods and Opposer's goods are advertised and sold in the same channels of trade.

12. Applicant's use and registration of KEEPSAFE is likely to cause confusion, deception, and/or mistake with respect to Opposer and Opposer's KEEPITSAFE Marks.

13. Applicant's use and registration of KEEPSAFE is likely to falsely suggest a connection with Opposer and Opposer's KEEPITSAFE Marks.

14. Applicant's use and registration of KEEPSAFE will interfere with Opposer's KEEPITSAFE Marks, both individually and collectively, and will damage Opposer, its business and its goodwill.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's mark and prays that it be denied.

The requisite filing fee prescribed by 37 C.F.R. § 2.6(a)(17), in the amount of \$300.00, should be charged to Deposit Account No. 500417. If there are any additional fees due in connection with this Notice of Opposition, they should also be charged to Deposit Account No. 500417, and any excess fees should be credited to same. All correspondence relating to this matter should be directed to the undersigned attorneys for Opposer.

Respectfully submitted,

J2 GLOBAL, INC.

Dated: April 8, 2014

By: /Robert W. Zelnick/
Robert W. Zelnick
McDERMOTT WILL & EMERY LLP
500 North Capitol Street, NW
Washington, D.C. 20001
Telephone: (202) 756-8000
Facsimile: (202) 756-8087

Bess Morgan
McDERMOTT WILL & EMERY LLP
2049 Century Park East, Suite 3800
Los Angeles, CA 90067
Telephone: (310) 788-1557
Facsimile: (310) 277-4730

Attorneys for Opposer

CERTIFICATE OF SERVICE

Opposer J2 GLOBAL, INC., by and through its attorneys, hereby certifies that a copy of this NOTICE OF OPPOSITION has been served upon Applicant's counsel of record on this 8th day of April, 2014, by First Class Mail at the following addresses:

JOHN W. CRITTENDEN
COOLEY LLP
1299 PENNSYLVANIA AVE NW STE 700
WASHINGTON, DISTRICT OF COLUMBIA 20004-2400
UNITED STATES

ARIANA HISCOTT
COOLEY LLP
101 CALIFORNIA STREET, 5TH FLOOR
SAN FRANCISCO, CA 94111

/ Robert W. Zelnick/_____
Robert W. Zelnick
McDERMOTT WILL & EMERY LLP
Attorney for Opposer

DM_US 50826343-1.085600.0369

EXHIBIT A

United States of America

United States Patent and Trademark Office

KEEPITSAFE

Reg. No. 4,234,642

Registered Oct. 30, 2012

Int. Cls.: 9 and 42

TRADEMARK

SERVICE MARK

PRINCIPAL REGISTER

KEEPITSAFE DATA SOLUTIONS, LTD. (IRELAND CORPORATION)
C/O ARTHUR COX BUILDING
EARLSFORT CENTRE, EARLSFORT TERRACE
DUBLIN 2, IRELAND

FOR: COMPUTER PROGRAMS FOR USE IN PROCESSING DATA IN THE FIELDS OF DISASTER RECOVERY, DATA ARCHIVAL AND DATA BACKUP; DATABASE MANAGEMENT SOFTWARE FOR USE IN THE FIELDS OF DISASTER RECOVERY, DATA ARCHIVAL AND DATA BACKUP; COMPUTER PROGRAMS FOR PROVIDING REMOTE DATA ARCHIVAL AND BACKUP, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 10-19-2006; IN COMMERCE 10-19-2006.

FOR: COMPUTER SERVICES, NAMELY, DATA RECOVERY SERVICES; COMPUTER DISASTER RECOVERY PLANNING SERVICES IN THE FIELD OF DATA COMMUNICATIONS SYSTEMS, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 10-19-2006; IN COMMERCE 10-19-2006.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SN 85-248,343, FILED 2-22-2011.

REBECCA SMITH, EXAMINING ATTORNEY



David J. Kyffers

Director of the United States Patent and Trademark Office

United States of America

United States Patent and Trademark Office



Reg. No. 4,203,061

Registered Sep. 4, 2012

Int. Cls.: 9 and 42

TRADEMARK

SERVICE MARK

PRINCIPAL REGISTER

KEEPIITSAFE DATA SOLUTIONS, LTD. (IRELAND CORPORATION)
C/O ARTHUR COX BUILDING
EARLSFORT CENTRE, EARLSFORT TERRACE
DUBLIN 2, IRELAND

FOR: COMPUTER PROGRAMS FOR USE IN PROCESSING DATA IN THE FIELDS OF DISASTER RECOVERY, DATA ARCHIVAL AND DATA BACKUP; DATABASE MANAGEMENT SOFTWARE FOR USE IN THE FIELDS OF DISASTER RECOVERY, DATA ARCHIVAL AND DATA BACKUP; COMPUTER PROGRAMS FOR PROVIDING REMOTE DATA ARCHIVAL AND BACKUP, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 10-19-2006; IN COMMERCE 10-19-2006.

FOR: COMPUTER SERVICES, NAMELY, DATA RECOVERY SERVICES; COMPUTER DISASTER RECOVERY PLANNING SERVICES IN THE FIELD OF DATA COMMUNICATIONS SYSTEMS, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 10-19-2006; IN COMMERCE 10-19-2006.

THE MARK CONSISTS OF THE WORDING "KEEPIITSAFE" TO THE RIGHT OF A STYLIZED SAFE DESIGN.

SN 85-248,346, FILED 2-22-2011.

REBECCA SMITH, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office